

REMARKS

In response to Applicant's February 24, 2005 after-final Amendment and Response, the Examiner issued an Advisory Action and indicated that Applicant's amendments would not be entered. The Examiner alleged that the amendments raise new issues that would require further consideration and possibly a new search as well. The Examiner also raised the issue of possible new matter having been introduced by the amendments. The Examiner referred to the disclosure on page 7 of the instant specification and asserted that it "does not describe measuring gastric accommodation during a ramp and tonic phrase but only a tonic phase, which is after a ramp phase, as set forth in the claims prior to the amendment." The Examiner has asked that Applicant point out support in the instant specification for the amendments to claim 1.

In response to the Examiner's assertion and request, Applicant wishes to point out the following:

- 1) The term "accommodation" is defined on page 3, lines 28 and 29 of the specification as "the adjustment of the volume of the stomach, e.g., contraction or expansion, in response to a change in pressure, or a change in content."
- 2) The volume response is measured during each of the four phases of the stomach distension, i.e., a) the start phase, b) the ramp phase, c) the tonic phase and d) the end phase (see

page 3, lines 2-9 of the specification). Thus, the accommodation is measured during, inter alia, the ramp phase (page 3, lines 2-6) and the tonic phase (page 3, lines 7 and 8).

Claim 1 was amended in Applicant's previous response precisely to make this clarification, i.e., that the instantly claimed method comprises measuring the gastric accommodation during a ramp phase and during a tonic phase and from these measurements determining the maximum gastric accommodation capacity. Thus, claim 1 as amended previously and presented again herein is certainly unambiguously derivable from, and supported by, the application as filed, and there is no question of new matter.

In light of the full support for the amendments previously made to claim 1, claims 1-5 presented herein for examination are identical to the claims that were presented for examination on February 24, 2005 but not entered by the Examiner. Furthermore, the remarks presented below are essentially the same as those presented in the February 24, 2005 Amendment and Response to address the issues raised in the November 24, 2004 final Office Action. It is Applicant's understanding that, in light of the finality of the rejection and the alleged new issues raised by the amendment of claim 1, the Examiner did not give full consideration to these arguments. It is respectfully requested that, in light of the RCE submitted concurrently herewith and

the concomitant withdrawal of the final rejection, the Examiner give full consideration to Applicant's showing.

Claims 1, 2 and 5 remain rejected under 35 U.S.C. §102(b) as being anticipated by US 5,912,235 to Hoeltje et al. In short, the Examiner asserts that the instantly claimed determination of gastric accommodation after a ramp phase is inherent in the Hoeltje teaching of measurement of stomach volume at constant pressure.

Claim 1 has been further amended to more clearly recite the subject matter regarded as the invention. As amended herein, the claim makes clear the distinction between measurement of gastric accommodation and determination of maximum gastric accommodation capacity. The amended claim recites that, following administration of the test compound, the gastric accommodation is measured during a ramp phase, i.e., a phase wherein the pressure applied to the balloon is increased linearly with a constant increase in pressure and during a tonic phase, i.e., after the ramp phase, and that the maximum gastric accommodation capacity is determined subsequently to, and based on, those measurements. This amendment to the claim finds support on page 3, lines 28 and 29, and on page 7, lines 5-12 of the instant specification. As amended, claim 1 recites a step that clearly is not taught by Hoeltje, nor can it be said that this step is inherent in the methodology of Hoeltje.

Claim 3 remains rejected as obvious over the combination of the same Hoeltje patent as primary reference in combination with US 5,000,953 to Ui et al., and claim 4 remains rejected as being obvious over the same Hoeltje patent as primary reference in combination with US 5,552,398 to King et al. The Examiner invokes Ui as supplying the teaching of using Wistar rats as test animals, a teaching acknowledged to be missing from Hoeltje. Similarly, the Examiner invokes King as disclosing 5HT-4 antagonists as compounds with potential for treating dyspepsia, a teaching also acknowledged to be missing from the Hoeltje reference. In any case, these specific teachings of the cited secondary references cannot make up for the fundamental differences between the method described by Hoeltje and the instantly claimed method.

The method described by Hoeltje is meant to identify compounds that increase the stomach tone and stimulate gastric emptying, not to identify compounds that increase the gastric accommodation. In the Hoeltje method, the stomach volume and the relative reduction in stomach volume caused by the stomach-tone-increasing action of the test compounds is measured; neither gastric accommodation nor maximum gastric accommodation capacity is determined by the Hoeltje method.

One of skill of the art at the time of the present invention would have had no reason to measure gastric

accommodation or to determine maximum gastric accommodation capacity in connection with the Hoeltje method, since the effect being sought in the Hoeltje test compounds is that of increasing the stomach tone. This is further evidenced by the fact that the first step of the Hoeltje method is the administration of lipids, which causes the relaxation of the stomach. The stomach-tone-increasing compound is subsequently administered and the stomach volume changes measured.

By contrast, the instantly claimed method seeks to identify test compounds which increase the gastric accommodation capacity and thus lead to an increased relaxation of the stomach. For the determination of whether a particular test compound is useful in the treatment of an impaired maximum gastric accommodation capacity, it is essential to determine the gastric accommodation.

It should be clarified that it is the gastric accommodation caused by passive relaxation, dependent on elasticity of the stomach wall, that is determined during the ramp phase. On the other hand, it is the gastric accommodation caused by active relaxation, i.e., the relaxation caused by vagal reflexes, that is determined during the tonic phase. Hence, a particularly accurate determination of the maximum gastric accommodation is made when the gastric accommodation is measured both during a ramp phase and during a tonic phase. The benefit of doing so is

that the results also reflect the influence of the vagal reflexes, which is independent of any contribution from passive relaxation dependent on the elasticity of the stomach wall.

There is nothing in the Hoeltje reference that remotely takes this aspect into consideration. In fact, as mentioned above, the Hoeltje reference, if anything, teaches away from the presently claimed method in that Hoeltje is concerned with the problem of identifying compounds that increase stomach tone, the inverse of the problem that the instantly claimed method seeks to solve. Furthermore, the specific Ui and King teachings invoked by the Examiner do nothing to alleviate this situation, nor does any other disclosure of these secondary references provide any remedy.

The Examiner leveled a new rejection of the pending claims, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted that the language added by amendment in Applicant's October 15, 2004 response provides a scope of claim that is not sufficiently described in the instant specification. Applicant notes that the Examiner has indicated that amendment of the claim to recite that the determination is made "after a ramp phase and during a tonic phase" would be remedial. As amended herein, the claim recites that the measurement of gastric accommodation is made "during a ramp phase and during a tonic phase." As pointed out

earlier, this language is fully supported by the instant specification. Furthermore, the claim amendment clearly defines a window of time for making the measurements that is enabled by the specification, thus addressing the Examiner's concern.

Applicant also notes the Examiner's comments with regard to the Nordling thesis and abstract made of record in the IDS submitted October 15, 2004. With regard to the date of distribution of the abstract, the Examiner is advised that distribution occurred on or about the time of presentation of the thesis, in any case prior to the filing date of the instant application. Should the Examiner require further information at a later date regarding the distribution of the abstract, Applicant will endeavor to comply. However, and in any event, it is Applicant's contention that, whether or not the Nordling abstract qualifies as a publication by virtue of its distribution quantity, neither the thesis nor the abstract qualify as "prior art" in the sense that they teach or suggest the instantly claimed invention.


The invention as claimed is free of the cited prior art. The issue raised in the November 24, 2004 final Office Action with respect to written description and that raised in the March 31, 2005 Advisory Action with respect to new matter have also been addressed. The application is in condition for allowance; reconsideration and allowance with pending claims 1-5 are

respectfully requested. Should any other matters require attention prior to allowance, it is requested that the Examiner contact the undersigned.

The Commissioner is hereby authorized to charge any additional fees which may be due for any reason in connection with this communication to Deposit Account No. 23-1703.

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Respectfully submitted,


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